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Don T. Cameron

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HANIFY & KING PROFESSIONAL CORPORATION
1875 K STREET, NW
SUITE 707
WASHINGTON, DC 20006

EXAMINER

MCCORMICK, GABRIELLE A

ART UNIT

PAPER NUMBER

3629

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/736,641	Applicant(s) CAMERON ET AL.	
	Examiner Gabrielle McCormick	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 11-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 11-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. This action is in reply to the amendment filed on June 27, 2008.
2. Claim 1 has been amended.
3. Claims 28 and 29 have been added.
4. Claims 9 and 10 have been canceled.
5. Claims 1-8 and 11-29 are currently pending and have been examined.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-8 and 11-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
8. The term "substantially" in claim 1 is a relative term which renders the claim indefinite. The term "substantially" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Page 5, line 19 of the specification discloses that a "determination is then made whether the features substantially conform to the manufacturing specifications." Discussion follows regarding deviations due to normal use of the product. It is unclear whether if the determination that the product does not substantially conform whether this could be due to abnormal use, extreme use or that the product's features do not match some or all of the manufacturing specifications. Further, the definition of "normal" use, were it to be incorporated into the claim language, would similarly raise questions of clarity, as it too is a relative term. Claims 2-8 and 11-29 are rejected based on their dependency from claim 1.

9. The Examiner considered the argument provided by the Applicant, however, the rejection is maintained, as discussed above. The Examiner agrees that the specification provides examples of conditions that result in a deviation from manufacturing specifications ("a golf putter may become nicked or other marked or scratched through normal use thereof"), however, the specification does not define the metes and bounds of how golf equipment would be deemed to be either substantially conforming to or nonconforming to manufacturing specifications. How much deviation, in which manufacturing specification, is acceptable to be within the bounds to "substantially conform"? For example, does a club that is determined to be authentic, yet altered, substantially conform? And if it does, how would one determine which alterations "substantially conform"? Does a club in poor condition (i.e., indicating that it is badly damaged (pg. 7; line 11)) "substantially conform"?

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. **Claims 1-8, 13, 15-16, 18-19 and 23-27** are rejected under 35 U.S.C. 103(a) as being unpatentable over Callaway (pages documented from the Internet Archive from November 29, 2002 at <http://web.archive.org/web/20011020005809/www.callawaygolfpreowned.com/trade-rules.html>; <http://web.archive.org/web/20020601221544/www.callawaygolfpreowned.com/guarantee.html>; <http://web.archive.org/web/20021203111831/www.callawaygolfpreowned.com/c016871c.html>; <http://web.archive.org/web/20020601224341/www.callawaygolfpreowned.com/condition.html>) in view of Cohen (US Pub. No. 2003/0050891).

12. **Claims 1-7, 13, 15, 19 and 27:** Callaway discloses a method where used Callaway golf clubs can be traded in for either new or previously owned clubs. The method involves mailing the club for trade to Callaway (pg. 1; III), verifying the club (pg. 1; VI) and returning an unacceptable club (pg. 2; bullets 5&6). Clubs that are accepted are given a "Certified Preowned title" (i.e., results are reported) after passing a "meticulous inspection." Callaway provides a SKU # (pg. 4). It is obvious that as the manufacturer of the preowned clubs, Callaway would have access to manufacturing specifications and would therefore determine whether the features of the traded clubs conform to the manufacturing specifications. It is inherent that as the manufacturer, Callaway is an authorized authenticator. On pages 4 and 5, Callaway discloses features of a certified preowned club, including physical dimensions (loft), materials (graphite), manufacturer markings ("Callaway" in the photo), shape (driver), stamping (see bottom of club in photo), shaft (Callaway BBUL Graphite) and condition (fair). Callaway provides definitions for grading the condition of preowned clubs based on the number of rounds of golf played. (pg. 6). These results are available through a website link. (pg. 4).
13. Callaway does not disclose the *finish, paint fill grip or weight*.
14. However, these differences are only found in the **nonfunctional descriptive data** and are not functionally involved in the steps recited. **The identification of relevant features would be performed regardless of specific features such as finish, paint fill, grip and weight.** Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).
15. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included finish, paint fill, grip and weight because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of relevant features does not patentably distinguish the claimed invention. It is obvious that in Callaway's disclosure of additional features such as gender, lie angle, hand and flex that the relevant features that Callaway deems necessary to aiding in the sale of certified preowned clubs

is provided and that should additional information be necessary, Callaway would be capable of providing it.

16. Callaway does not disclose linking unique registration numbers for equipment authenticated two or more times.
17. Cohen, however, discloses a tracking check that can correspond to an item or a plurality of items, such as a set of golf clubs. (P[0062]). Information about the item and the chain of ownership are registered in a database. (P[0063]). The tracking check also tracks an item when title is not conveyed, such as when an item requires servicing. (P[0085-0088]). The system tracks the change of possession between an owner and a service center, thus documenting the possession and service history. (P[0088]). Though Cohen does not disclose that the service center assigns a unique registration number each time service is performed, it is obvious that a service center would assign a unique number such as an invoice number in order to track the servicing fees and charge the customer. Accounting systems utilizing invoice numbers are old and well known. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included invoice numbers, in the system of Cohen for the motivation of providing service centers with a means to bill customers for services. Thus, Cohen's system, when combined with the old and well known accounting system that uses an invoice for billing, creates a link between the servicing of an item and the possession history whereby a service history is created for the item.
18. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included tracking an item's possession and service history, as disclosed by Cohen, in the system of Callaway for the motivation of establishing a chain of titleholders that can be used by insurance companies and law enforcement to determine ownership. (Cohen; P[0046]). Further, by documenting repair and service histories and records of the quality of work and type of work performed (P[0048]) higher resale value in the future may result. (P[0088]). Callaway would be motivated to link records of equipment each time it is authenticated to create a detailed history of the equipment's possession and use. It is obvious for Callaway to protect the brand and image of

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quality associated with its clubs, therefore, a database tracking club trades would ensure that stolen clubs would not be permitted to be accepted for trade. It is old and well known for companies to request owners of products to register the purchase in order to establish ownership, therefore, it is obvious for Callaway to track ownership throughout a club's life. As Callaway does not preclude a club being traded more than once, it is obvious that Callaway would employ a database to capture the sales and authentication history of each club.

19. **Claims 8:** Callaway receives the club and performs a "meticulous inspection" as part of the certification process. (pg. 3). Though Callaway does not disclose a first or second view, it is inherent that the club is viewed numerous times and from numerous angles during the inspection.
20. **Claims 16 and 18:** Callaway discloses a "Certified Preowned title" (pg. 3). The word "Callaway" on the pictured "Certificate of Authenticity" is a seal. It cannot be determined whether "Callaway" is embossed. Further, a picture or a reference number is not disclosed with the Certificate, however, on page 4, a photo and a SKU # are provided for a club offered for sale as a certified preowned club.
21. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included the photo and SKU with the certificate for the motivation of providing increased assurance to the purchaser of the club that the club is traceable to the certificate. It is old and well known to provide details linking a physical product to a document that certifies its characteristics for quality assurance and traceability purposes. Embossing the word "Callaway" would be an obvious addition to the certificate as a means of preventing forged copies of the certificate.
22. **Claims 23-26:** Callaway discloses a mailing label (pg. 1; V). The mailing label would be created through an automated process when it is printed using standard print commands that inherently reside on an Internet browser. Callaway is notified of the request in step V: "Mail a copy of the Trade in Form along with the club to be traded". Furthermore, it is obvious that the Trade in Form would also serve as a packing slip as it would provide a description of the club to be traded in.

23. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included using the Trade in Form as a packing slip for the motivation of providing a method of providing a paper trail to verify that the correct item was mailed.
24. **Claims 11-12, 14 and 17** are rejected under 35 U.S.C. 103(a) as being unpatentable over Callaway (pages documented from the Internet Archive from November 29, 2002 at <http://web.archive.org/web/20011020005809/www.callawaygolfpreowned.com/trade-rules.html>; <http://web.archive.org/web/20020601221544/www.callawaygolfpreowned.com/guarantee.html>; <http://web.archive.org/web/20021203111831/www.callawaygolfpreowned.com/c016871c.html>; <http://web.archive.org/web/20020601224341/www.callawaygolfpreowned.com/condition.html>) in view of Cohen (US Pub. No. 2003/0050891) in further view of Chester (US Pub. No. 2004/0054888).
25. **Claims 11 and 12:** Callaway discloses the method of claim 1. Callaway does not disclose *comparing the equipment to a previously prepared record of the equipment*.
26. Chester, however, discloses “verifying the authenticity and ownership of a registered item or article by querying the accrediting authority”, transferring an item, issuing a new certification of authenticity to new purchaser and registering the transferred item or article and new owner. (P[0016]). During verification and title transfer, the correct owner and “a static digital image” (i.e., picture) is provided. (P[0032]). Thus, Chester provides access to a previous record and a picture.
27. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included comparison to previous records and pictures, as disclosed by Chester, in the system of Callaway for the motivation of verifying ownership at the time of trade-in. Callaway would be motivated to access previous records and photos to ensure that a club received had not been stolen from a registered owner. It is old and well known that companies track the ownership of products sold for various purposes, including offering new product promotions.
28. **Claims 14 and 17:** Callaway discloses the methods of claims 1 and 16. Callaway does not disclose *making an indicia or providing said reference number on the equipment*.

29. Chester, however, discloses a "hologram with embedded attributes with encrypted protection and password or personal identification number...for use with each separate item or article to be authenticated by each authorized distributor..." (P[0029]).
30. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included indicia and reference number on an authenticated item, as disclosed by Chester, in the system of Callaway for the motivation of linking the item to a certificate of authentication.
31. **Claims 20-21** are rejected under 35 U.S.C. 103(a) as being unpatentable over Callaway (pages documented from the Internet Archive from November 29, 2002 at <http://web.archive.org/web/20011020005809/www.callawaygolfpreowned.com/trade-rules.html>; <http://web.archive.org/web/20020601221544/www.callawaygolfpreowned.com/guarantee.html>; <http://web.archive.org/web/20021203111831/www.callawaygolfpreowned.com/c016871c.html>; <http://web.archive.org/web/20020601224341/www.callawaygolfpreowned.com/condition.html>) in view of Cohen (US Pub. No. 2003/0050891) in further view of Greenwichgolf.com ((pages documented from the Internet Archive at <http://web.archive.org/web/20020605164840/greenwichgolf.com/ser02.htm>).
32. **Claims 20-21:** Callaway discloses the method of claim 1, however, Callaway does not disclose altering the equipment from its original condition.
33. Greenwichgolf.com discloses offering alterations to golf equipment.
34. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included altering equipment, as disclosed by Greenwichgolf.com, in the system of Callaway for the motivation of making lies right for a person's swing. (Greenwichgolf.com).
35. It is would have been obvious to one of ordinary skill in the art at the time of the invention to have included reporting how the equipment was altered. Callaway discloses on pages 4 and 5 "Lie Angle: Standard" and "Length: Standard". It would have been obvious that had the club been altered from "Standard", that it would have been reported.

36. **Claim 22** is rejected under 35 U.S.C. 103(a) as being unpatentable over Callaway (pages documented from the Internet Archive from November 29, 2002 at <http://web.archive.org/web/20011020005809/www.callawaygolfpreowned.com/trade-rules.html>; <http://web.archive.org/web/20020601221544/www.callawaygolfpreowned.com/guarantee.html>; <http://web.archive.org/web/20021203111831/www.callawaygolfpreowned.com/c016871c.html>; <http://web.archive.org/web/20020601224341/www.callawaygolfpreowned.com/condition.html>) in view of Cohen (US Pub. No. 2003/0050891) in further view of Harreld ("Scrutinizing the numbers". InfoWorld. San Mateo: Aug. 19, 2002. Vol 24, Iss. 33; pg. 35).
37. **Claim 22:** Callaway discloses the method of claim 1. Callaway does not disclose a color-coded certificate based on results.
38. Harreld, however, discloses the executive receive color-coded reports highlighting any variances from performance goals. (pg. 2; para. 12).
39. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included color coding certificates based on results, as disclosed by Harreld, in the system of Callaway for the motivation of providing a visual alert. For example, if a club was listed as Condition: Very Good, color-coding would provide a visual clue that would direct potential buyers to that listing and therefore increase the likelihood of selling the club.
40. **Claims 28 and 29** are rejected under 35 U.S.C. 103(a) as being unpatentable over Callaway (pages documented from the Internet Archive from November 29, 2002 at <http://web.archive.org/web/20011020005809/www.callawaygolfpreowned.com/trade-rules.html>; <http://web.archive.org/web/20020601221544/www.callawaygolfpreowned.com/guarantee.html>; <http://web.archive.org/web/20021203111831/www.callawaygolfpreowned.com/c016871c.html>; <http://web.archive.org/web/20020601224341/www.callawaygolfpreowned.com/condition.html>) in view of Cohen (US Pub. No. 2003/0050891) in further view of Solheim (US Pub. No. 2002/0077956).

41. **Claim 28:** Callaway/Cohen discloses a website, but does not disclose tracking the progress of authentication.
42. Solheim, however, discloses a system for authenticating golf clubs as part of an on-line auction where the authenticator provides intransit authentication, repair and custom fitting of used golf clubs. (P[0006]). Automatic emails are sent, the authenticator forwards escrowed monies to seller, performs the requested services and ships the items to the bidder. (P[0020]). It is inherent that the host system of the manufacturer (P[0019]), i.e., the authenticator, tracks the progress of the authentication in order to release funds to the seller, perform the requested services and ship to the bidder. Therefore, it is obvious to replace the email notification with website tracking as it is old and well known to check the status of an order via a manufacturer's website.
43. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included website tracking, in the system of Solheim for the motivation of providing an alternation to email notification of status.
44. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included website tracking of authentication progress, as disclosed by Solheim, in the system of Callaway for the motivation of providing Callaway with a profit center similar to that disclosed by Solheim where the club manufacturer (i.e., Callaway) links its preowned club sales to an on-line auction site, such as eBay, as a means of both generating additional sales revenue and ensuring that counterfeit Callaway Clubs are not sold. Solheim discloses that the manufacturer is Ping, which is a competitor of Callaway, therefore, it is obvious that Callaway would be motivated to provide similar authentication and custom fitting services.
45. **Claim 29:** Callaway discloses ratings (i.e., indicia of conditions of the equipment). (pg. 6), but does not disclose that these conditions relate to original and modified parts.
46. Solheim discloses an authentication service that additionally provides fitting and repair, including new grips and new shafts (P[0016]), thus disclosing original and modified parts.
47. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included original and modified parts, as disclosed by Solheim, in the rating system of

Callaway for the motivation of fully disclosing to a potential purchaser the state of the equipment. It is obvious that in passing a "meticulous inspection" that Callaway would note original versus modified parts as this would impact the desirability of the club, as well as the acceptance for trade as a Callaway product.

Response to Arguments

Applicant's arguments with respect to claim 1 has been considered but are moot in view of the new ground(s) of rejection as detailed above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gabrielle McCormick whose telephone number is (571)270-1828. The examiner can normally be reached on Monday - Thursday (5:30 - 4:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/G. M./
Examiner, Art Unit 3629

/John G. Weiss/
Supervisory Patent Examiner, Art Unit 3629